

REMARKS

Claim Amendments/Possible Outstanding Issues

Claim 38 is objected to being dependent on a rejected base claim and is noted allowable once rewritten in independent form including all the limitations of the base claim. Claim 38 is rewritten in independent form and suitable dependent claims are added.

The base claim for claim 38 is claim 30, which includes the feature (aligning layer with a surface sufficiently smooth such that liquid crystal films formed thereon can be removed in one piece) rejected under section 112, first paragraph.

The Office Action alleges that there is no written description for such feature in the specification. Applicants point the Examiner's attention to page 18, where on lines 18-24 applicants teach that the surface roughness is a major problem, which prevents the film from easily being released from the surface after UV curing. On the same page on lines 33-35, applicants teach that this problem can be overcome by the use of substrates, which have been coated with "sufficiently smooth Al₂O₃." While the specification does not use the exact literal language used in the claims, written description and support for the claimed matter is in the specification. Applicants do not state explicitly that the film is removed in one piece; however, one of ordinary skill in the art would clearly understand that such is desired/intended as a broken/torn film is not a desirable product. There is no requirement for literal support for claimed subject matter. See *Ex parte Parks*, 30 USPQ2d 1234 (BPAI 1993)

In rejecting a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, it is incumbent upon the examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that an appellant had possession of the now claimed subject matter. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Werthein*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). (Emphasis added.)

Applicants have clearly conveyed to one having ordinary skill in the art that applicants had possession of the concept of what is claimed.

Base claim 30 includes the feature (surface sufficiently smooth such that liquid crystal films formed thereon can be removed in one piece) rejected under section 112, second paragraph.

Allegedly the term “such that” renders the claim indefinite, where the metes and bounds of the claim are not clearly set forth. Applicants respectfully disagree. The term “such that” is not indefinite. The feature modified by the term, e.g., strength of the liquid crystal film, is defined by clear limitations where the metes and bounds of the claim are clear to one of ordinary skill in the art.

The term “such that” should not be confused or equated with the term “such as” which has been held indefinite in *Ex parte Steigerwald*, 131 USPQ 74 (BPAI 1961), since the two terms have different meanings, connotations and uses.

The term “sufficiently” is also rejected as it does not define any structure and thus allegedly does not distinguish. Applicants respectfully disagree. The “sufficiently” term here defines structure adequately by the use of functional language that one of ordinary skill in the art can clearly understand the scope of the claim. The term modifies the smoothness of an Al₂O₃ layer that has a definite requirement, e.g., such that a liquid crystal film formed thereon can be removed in one piece. The specification, as discussed above, teaches that the ability to release the film from the Al₂O₃ layer depends on the Al₂O₃ layer’s smoothness. See page 18 of specification and discussion above. One of ordinary skill in the art can clearly understand the scope of this limitation without further structural limitations being explicitly defined in the claim and can easily determine whether a certain smoothness satisfies the claimed requirement by forming a film on an Al₂O₃ layer and then attempting to remove the same.

The Office Action also alleges that the recitations that the liquid crystal film “can be” removed in one piece is not a positive limitation and thus does not constitute a limitation in any patentable sense. Applicants once again disagree. Whether the surface an Al₂O₃ layer is smooth enough to satisfy the claimed limitation that the liquid crystal film “can be” removed in one piece is a clear positive limitation. One of ordinary skill in the art, as discussed above, can easily understand the limitation on

the smoothness of the surface and can also easily determine whether a given Al₂O₃ layer satisfies the claimed limitation.

Claims 36 and 40 are alleged to be directed to non-elected subject matter, i.e., embodiments with an aluminum coating as the aligning layer. However, claims 36 and 40, as well as amended claim 41, define a further aspect of the Al₂O₃ layer already claimed more broadly in independent claim 38, and not of an aluminum layer. Thus, there is no basis for treating these claims as non-elected subject matter or inappropriate claims for any other reason. These claims are dependent on an allowable claim, and thus, must by definition satisfy the features of the allowed claim, e.g., no further search is required to establish their patentability, e.g., may only require a cursory review to have them allowed. Their consideration is respectfully and courteously requested.

Allowance of the application is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Csaba Henter, Reg. No. 50,908
Richard J. Traverso, Reg. No. 30,595
Attorneys for Applicant(s)

MILLEN, WHITE, ZELANO & BRANIGAN,
Arlington Courthouse Plaza I
2200 Clarendon Boulevard, Suite 1400
Arlington, Virginia 22201
(703) 812-5310 [Direct Dial]
E-mail address: traverso@mwzb.com

June 10, 2004

K:\Merck\1883\c1\Reply June 04.doc